



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/502,057

10/28/2004

Klaus Schultes

254577US0PCT

2518

22850

7590

04/08/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

04/08/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/502,057	<b>Applicant(s)</b> SCHULTES ET AL.	
	<b>Examiner</b> Margaret G. Moore	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4 to 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 to 18, 20, 21 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/9/09, 8/7/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1796

1. The following rejections are maintained from the prior prosecution. Since the basis for each of these rejections has been thoroughly noted, the rationale will not be repeated.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4 to 6, 9 to 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geck et al.

4. Claims 1, 2, 4 to 7, 9 to 15, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mautner et al.

5. Applicants' traversal to these rejections is the same as that noted in previous responses, including the Appeal Brief filed 11/13/06. The Examiner has already addressed the obviousness of the 50:50 to 1:99 range and the fact that the results in the specification, as shown on pages 13 and 14 of the response filed 12/18/08, are insufficient in overcoming these rejections. As such this will not be repeated.

6. For the rejection over Geck et al., please note the following:

For claim 17, please see the working examples in which R' is present in 5 mol% and is a combination of methacryloxypropyl and methyl groups. From this it follows that less than 5 mol% vinyl groups are present. Since these groups are necessary for grafting the outer layer onto the silicone core, the skilled artisan would have been motivated to adjust the amount of methacryloxypropyl groups in the siloxane core in an effort to optimize the degree of grafting. From this one having ordinary skill in the art

Art Unit: 1796

would have found an amount of vinyl radicals meeting the claimed range to have been obvious.

For claim 18, while this reference does not specifically mention an higher amount of vinyl groups on the outer region, since the vinyl groups are used to subsequently graft an outer layer onto the silicone core, it would follow that the skilled artisan would want the vinyl groups to be on the outer surface of the silicone core. This will expedite and optimize the subsequent grafting step.

For claim 20, see column 3, line 25.

7. For the rejection over Mautner et al., please note the following:

For claim 17, please see column 3, lines 50 to 54, which renders obvious the claimed range. Also see Example 1 which meets this limitation.

For claim 18, while this reference does not specifically mention an higher amount of vinyl groups on the outer region, since the vinyl groups are used to subsequently graft an outer layer onto the silicone core, it would follow that the skilled artisan would want the vinyl groups to be on the outer surface of the silicone core. This will expedite and optimize the subsequent grafting step.

For claim 20, see the abstract.

8. Claims 1, 2 and 4 to 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18 to 25 of copending Application No. 10/501,467. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 1, 2, 4 to 18, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandstetter in view of Geck et al. or Mautner et al.

Art Unit: 1796

Applicants rely on their arguments for the Geck et al. and Mautner et al. rejections, *supra*, in overcoming this rejection. Since this is not persuasive (for reasons of record), this rejection is maintained.

For new claim 21, the Examiner notes that this combines the limitations of claims 1 and 8, both of which were rejected by this combination of references. As noted in paragraph 10 of the previous office action, Brandstetter teach an amount of acrylonitrile that overlaps with and renders obvious the claimed range of from 8 to 30 wt%.

10. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest such a limitation in combination with the totality of the limitations found in claim 1.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-

Art Unit: 1796

272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/  
Primary Examiner, Art Unit 1796

mgm  
3/31/09